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APR 14 2010

OFFICE OF PETITIONS

In re Application of :
Martin :
Application No. 09/413,105 :
Filed: October 6, 1999 :
Attorney Docket No. 99-008-02-US :
For: SEQUENTIAL UNLOAD PROCESSING :
OF IMS DATABASES :

DECISION ON PETITION

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term modification entitled "Petition for Reconsideration of Patent Term," received on December 28, 2009.

The petition under 37 CFR 1.182 is dismissed.

Petitioner notes that the Notice of Allowance mailed on December 14, 2009, for the above-identified application stated that the Patent Term Extension is 0 days and did not contain an indication of patent term adjustment. Petitioner asserts that "the correct Patent Term Adjustment/Extension is 2,858 days, on the basis of the USPTO's delay caused by effectively losing the application from 27 March 2001 through 22 January 2009".

Petitioner asserts that there were no circumstances where applicant failed to engage in reasonable efforts to conclude processing the present application. Petitioner asserts that the delays are attributable to the Office, as the Office improperly abandoned the application and then failed to timely treat the petition. Petitioner requests that the Office make a determination of Patent Term Adjustment and that the adjustment should be 2,858 days.

35 U.S.C. § 154(b) (as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000).

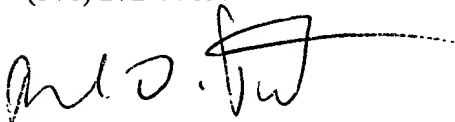
The above-identified application was filed on October 6, 1999. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Petitioner's assertion that the application is eligible for patent term adjustment provisions pursuant to 35 U.S.C. § 154 and 37 CFR 1.702 -1.705 is not persuasive. The effective date provision (§ 4405) in the legislation clearly states that the amendments to 35 U.S.C. § 154 apply to applications filed on or after the date that is 6 months after the date of enactment, i.e., May 29, 2000. This provision does not include applications that were filed prior to the date of enactment or even immediately after the date of enactment, but applications that were filed on or after the date that is 6 months after the date of enactment, see *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*, 65 FR 56366 (Sept. 18, 2000) 1239 Off Gaz. Pat. Office Notices 14 (Oct. 3, 2000).¹

Petitioner's assertion that the application is eligible for additional patent term under 37 CFR 1.182 due to the extraordinary length of the prosecution history, as it is unfair to Petitioner is not persuasive. The delay in the allowance and issuance is regrettable, but the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41 (a)(7). The required \$400 fee for the petition under 37 CFR 1.182 petition has been paid.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

¹ *Sykes v. Dudas*, 573 F.Supp 2d 191, 89 USPQ2d 1423 (D.D.C.2008).